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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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|-----------------|-------------|----------------------|---------------------|------------------|

09/728,152

12/01/2000

Michael H. Gilbert

F-120

4441

919 7590 06/30/2010

PITNEY BOWES INC.
35 WATERVIEW DRIVE
MSC 26-22
SHELTON, CT 06484-3000

EXAMINER

KARMIS, STEFANOS

ART UNIT

PAPER NUMBER

3693

NOTIFICATION DATE

DELIVERY MODE

06/30/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

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| APPLICATION NO./ CONTROL NO. | FILING DATE | FIRST NAMED INVENTOR / PATENT IN REEXAMINATION | ATTORNEY DOCKET NO. |
|---------------------------------|-------------|---|---------------------|
| 09728152 | 12/1/2000 | GILBERT, MICHAEL H. | F-120 |

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EXAMINER

STEFANOS KARMIS

| ART UNIT | PAPER |
|----------|----------|
| 3693 | 20100628 |

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

This communication is in response to the Patent Appeal Return Center noting that claims 17 and 18 were not included in the grounds of rejection.

Therefore, a corrected Grounds of Rejection section is listed below and the case will be forwarded back to The Board.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 1-5 and 8-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Savage, U.S. Publication No. 2002/0026394 A1.

Regarding the rejection of claims 1-5 and 8-16, the Examiner notes the decision of The Board of Patent Appeals and Interferences which issued a decision on the claims on 24 March 2009. In the decision, the Board found claims 1-5 and 8-16 to be unpatentable under 35 U.S.C. § 103(a) over Savage.

Applicant's amendment of generating by a fourth computer unit the bill based upon the billing information to the customer in the form of electronic data with billing information suitable for printing; and transmitting by a fourth computer unit the bill, to an optimal mailing location for printing and mailing to the customer has already been considered by The Board of Patent Appeals and Interferences (see Board Decision, mailed 24 March 2009, pages 11-12 and discussion regarding claim 6 and 7). Therefore, the

amendment to the claim 1 is entered and Applicant's argument is not persuasive.

4. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Savage, U.S. Publication No. 2002/0026394 A1 in view of Carlin U.S. Patent No. 6,697,843 B1.

Regarding the rejection of claims 6 and 7, the Examiner notes the decision of The Board of Patent Appeals and Interferences which issued a decision on the claims on 24 March 2009. In the decision, the Board found claims 6 and 7 to be unpatentable under 35 U.S.C. § 103(a) over Savage in view of Carlin. Since there are no new amendments to the claims, the rejection stands as stated by the Board.

/Stefanos Karmis/
Primary Examiner, Art Unit 3693